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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,064	06/20/2001	Takehiro Yoshida	35.C15468	1689

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EXAMINER

MENBERU, BENIYAM

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/884,064

Applicant(s)

YOSHIDA, TAKEHIRO

Examiner

Beniyam Menberu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on February 3, 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25, 29 and 33 is/are allowed.
- 6) ☒ Claim(s) 22-24, 26-28, and 30-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Response to Arguments***

1. Applicant's arguments filed January 4, 2006 have been fully considered but they are not persuasive. U.S. Patent No. 5815289 to Yoshida et al discloses a both sides original button (Figure 21b, reference 232) and both sides original lamp (Figure 21b, reference 234; column 23, lines 6-20) which indicate whether the document is both-side original (column 24, lines 27-42). The control circuit of Figure 21b (250) receives signal (234a), which determines whether both-side transmission is going to be used (column 25, lines 9-14). In figure 22a, step s672, control unit either follows the one-side procedures (s674-s680) or the both-side procedure (steps s682 and further). In the one-side procedure a simple read/transmission occurs (s678), but in the both-side transmission (steps s682 and further) the page information is transmitted (see Figure 26, steps s770 and s772) which replace steps s746 and step s754 in Figures 24 and 25 respectively. Further in the case of blank pages which correspond to blank sides of one-sided original, Yoshida et al teaches that these pages can be excluded (col. 28, line 5; col. 37, lines 54-58).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 22, 23, 24, 26, 27, 28, 30, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-17877 to Kido in view of U.S. Patent No. 5815289 to Yoshida et al.

Regarding claims 22, 26, and 30, Kido discloses a facsimile apparatus, method, and program (page 11, lines 6-8) for reading images of original sheets in which both-side and one-side original sheets exist mixedly and transmitting them to a receiver station, comprising:

reading means for reading the images on both sides of the original sheet (page 7, lines 5-8);

discriminating means for discriminating whether the images on both sides read by said reading means have effective image information or not (page 7, lines 18-21). However Kido does not disclose control means adapted for selectively determining use of a both-side transmitting procedure if both sides of the original sheet have effective image information or use of a one-side transmitting procedure if both sides of the original sheet do not have effective image information, for each transmission of one original sheet, in accordance with a result of the discrimination of said discriminating means; and for transmitting to the receiver station both-side transmission control information including a page number and information regarding front or reverse side of the original sheet, for each side of the original sheet, when said both-side transmitting procedure is used, and omitting the transmission of the both-side transmission control information, so that the page number is not transmitted to the receiver station, when the one-side transmitting procedure is used.

Yoshida et al disclose control means adapted for selectively determining use of a both-side transmitting procedure if both sides of the original sheet have effective image information or use of a one-side transmitting procedure if both sides of the original sheet do not have effective image information, for each transmission of one original sheet, in accordance with a result of the discrimination of said discriminating means (column 40, lines 37-40; column 41, lines 25-51; column 42, lines 1-4); and for transmitting to the receiver station both-side transmission control information including a page number and information regarding front or reverse side of the original sheet, for each side of the original sheet, (column 27, lines 21-26) when said both-side transmitting procedure is used, (column 27, lines 21-26; column 24, lines 56-63) and omitting the transmission of said both-side transmission control information when said one-side transmitting procedure is used (In Figure 22A, when both side is not selected for transmission in step s672, steps s674, s676, s678, s680 follows wherein no information regarding page number or page information is sent.).

Kido and Yoshida et al are combinable because they are in the similar problem area of facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the both side and one side facsimile information submission system of Yoshida et al with the facsimile system of Kido to implement effective transmission of mixed documents.

The motivation to combine the reference is clear because one-sided documents have only one page of information thus it is not necessary to send

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page information for such transmission but for both-side transmission Yoshida et al teaches that it is necessary to distinguish such transmission using the information that is received (column 49, lines 41-46).

Regarding claims 23, 27, and 31, Kido in view of Yoshida et al teach all the limitations of claims 22, 26, and 30 respectively. Further Yoshida et al disclose an apparatus, method, and program according to claim 22, wherein a count-up operation of said page number is executed only with respect to the both-side original sheet of which images on both sides have the effective image information (In figure 24 in step s750 and in figure 25, step s764, page counter is incremented for both sides transmission (Figure 22A, step 672)).

Regarding claims 24, 28, and 32, Kido in view of Yoshida et al teach all the limitations of claims 23, 27, and 31 respectively. Further Yoshida et al disclose an apparatus, method, and program, wherein the count-up operation of said page number is started after it is reset each time the both-side transmitting procedure is newly started (Figure 22a s668, s672 ("Yes"), Figure 22b s686, s688, Figure 23 s710, s712; column 25, lines 1-14, lines 25-30, lines 64-67; column 26, lines 1-2).

***Allowable Subject Matter***

4. Claims 25, 29, and 33 are allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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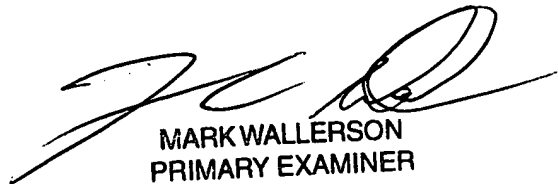
Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Patent Examiner**

Beniyam Menberu

BM

04/16/2006



MARK WALLERSON  
PRIMARY EXAMINER